

should be the end of the inquiry, Applicants reemphasize with this submission the technical arguments that led to that admission so that the written record in this application is as complete as possible.

### The Rejections

Claims 1-5, 7, 8, 10, and 17-20 are rejected under 35 U.S.C. § 103 as allegedly being obvious based on Lonstein et al. (Sound & Video Contractor, "Distributed Sound Systems Come of Age," December 20, 1993) in view of Lamb et al. (U.S. Patent 6,449,348). According to the Office Action, Lonstein shows all features of the invention set forth in those claims except for Category 5 cable being used to transmit audio signals and power on the same cable. However, according to the Office Action, that feature is shown in Lamb such that it allegedly would have been obvious to incorporate that feature into Lonstein to yield the claimed invention.

Claim 16 is rejected under 35 U.S.C. § 103 based on Lonstein "as applied to claim 1 above"<sup>2</sup> in further view of DU3 Users Guide PD-101-4-96.

Claims 6, 9, 11, 13-15, 21, and 22 are rejected under 35 U.S.C. § 103 based on "Lonstein above,"<sup>3</sup> and further in view of QED AUDIO PRODUCTS LTD., "An Introduction to Streamline," April 1988.<sup>4</sup>

Claim 23 is rejected under 35 U.S.C. § 103 based on "Lonstein/QED Audio Products as applied to claim 22 above" in view of DU3 Users Guide PD-101-4-96.<sup>5</sup>

Claims 12, 24, and 25 are rejected under 35 U.S.C. § 103 based on "Lonstein/QED Audio Products as applied to claim 11 above," and further in view of Systemline (S4.3 Multi-Room System Installation Manual).<sup>6</sup>

Applicants traverse these rejections on several grounds as set forth below and respectfully request that they be withdrawn.

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<sup>2</sup> As claim 1 (from which all other claims depend) was rejected based on Lonstein in combination with Lamb, it is clear that this rejection, as well as the other rejections summarized below, should have been expressed as being based on Lonstein in combination with Lamb.

<sup>3</sup> This rejection should have been expressed as being based on Lonstein in combination with Lamb.

<sup>4</sup> This rejection should have been expressed as being based on Lonstein in combination with Lamb.

<sup>5</sup> This rejection should have been expressed as being based on Lonstein in combination with Lamb.

<sup>6</sup> This rejection should have been expressed as being based on Lonstein in combination with Lamb.

Lamb is not Prior Art

Initially, Applicants note that Lamb does not constitute prior art with respect to this application. Applicants conceived and actually reduced their invention to practice in Australia prior to May 29, 1997 (the effective date of Lamb as a reference under 35 U.S.C. § 102(e)), as evidenced by the accompanying Rule 1.131 Declarations of Len Andrews and Andrew Goldfinch, Chris O'Sullivan, and Jacqui Israel.<sup>7</sup> Accordingly, the rejections should be withdrawn for at least that reason.

Lamb is Not Analogous Art

As noted above, Examiner Chin acknowledged during the June 13, 2006, interview that Lamb is not analogous art. More particularly, at the interview, Andrew Goldfinch presented technical data to explain some of the differences between and different considerations that pertain to designing an audio system such as the present invention and designing a telephony/data transfer system such as that shown in Lamb.<sup>8</sup> In response, Examiner Chin specifically "agree[d]" that a telephone/data transfer system is "different from" an audio distribution system. In other words, Applicants submit that Examiner Chin admitted that Lamb is nonanalogous art, such that one having skill in the art would not have considered it in designing a distributed music system such as the present invention. On that basis, too, the rejections should be withdrawn.

The Examiners Have Applied An Incorrect Standard for Combination Obviousness

Despite admitting that a telephony/data transfer system as shown in Lamb is "different from" an audio distribution system as per the present invention as noted above, Examiner Chin queried Applicants at the interview "What prevents him from thinking to use Cat 5 in stereo audio?" That query illuminates an erroneous standard for assessing combination obviousness the Examiners have apparently been applying. It is not an applicant's burden to demonstrate negatively that one having skill in the art would be prevented from thinking to make an asserted combination; to the contrary, it is an examiner's burden to demonstrate affirmatively that one having skill in the art would have been motivated to make a particular combination of references. Without such a showing, it becomes clear that a proffered combination of references

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<sup>7</sup> Under 37 C.F.R. 1.131, Applicants are entitled to rely on invention in a WTO country other than a NAFTA country as of January 1, 1996. (Australia became a member of the WTO effective January 1, 1995.)

<sup>8</sup> The information Mr. Goldfinch (himself being one of skill in the art) presented had been compiled by Nikola Korecki. A Declaration under 37 C.F.R. 1.132 from Mr. Korecki, to make that information part of the written record in this application, is filed herewith.

is nothing more than hindsight-based reconstruction of the claimed invention. Given the lack of meaningful motivation shown in this case to support the asserted combination of references,<sup>9</sup> Applicants submit that that (hindsight-based reconstruction) has been the case here. On that basis, too, Applicants request that the rejection be withdrawn.

#### Predicted Problems/Skepticism and Non-Obviousness

At paragraph 8 of the April 6, 2006, Office Action, the Examiner asserts that evidence Applicants submitted previously to demonstrate that others having skill in the art were skeptical that category 5 cable could be used successfully as Applicants have used it – classic evidence of non-obviousness – is not persuasive because “[t]he specification does not address whatsoever any special means or methods utilized to overcome such undesirabilities.” Similarly, the Interview Summary from the June 13, 2006, interview states that “[t]he specification does not address by what means or processes the audio and power signal must undergo prior to transmission through the category 5 cable in order to overcome undesirabilities of transmitting power and audio over category 5 cable [sic].” Therefore, Examiner Chin suggested that Applicants submit a Declaration for clarification. This position by the Office is troubling for several reasons.

First, there is no requirement in the patent laws, rules, or caselaw requiring an applicant to explain why or how his invention overcomes problems others have predicted would exist.<sup>10</sup> After all, it is entirely possible that the naysayers were just plain wrong – a scenario the applicant’s success would show strongly to have been the case. Thus, the Examiner’s imposition of such a requirement in the present case is unfounded and therefore improper.

Second, the Examiner’s position is logically flawed. The focus of the analysis is the obviousness *vel non* of the claimed invention. As noted above, evidence of skepticism by others having skill in the art that the claimed invention would work is classic evidence of non-

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<sup>9</sup> The Examiner supports the combination in the Office Action by asserting that “[s]ince it was well known at the time the invention was made that Category 5 cable can conduct both power and audio signals, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any well known cable such as category 5 based on design choice and the designers [sic] preference to conduct both audio and power signals.” That support is flawed for several reasons. First, it essentially says that any known cable whatsoever could be used, regardless of whether the cable is appropriate for the given application. As such, the statement paints with far too broad a brush. Second, the assertion fails to demonstrate *why* (but for Applicants’ own teaching) one having skill in the art would have had any such “preference to conduct both audio and power signals” in a distributed audio system such as that of the invention. Third, the Examiner’s presumption that one having skill in the art would have had such a preference is contradicted by the evidence already of record that people having skill in the art believed Category 5 cable could not successfully be used to power a distributed audio system.

<sup>10</sup> In fact, an applicant is not even required to know or understand how his invention works for it to be patentable.

obviousness. Therefore, to assert that that evidence is not persuasive because the specification is allegedly lacking in some regard is a complete *non sequitur*. In other words, the rebuttal has nothing to do with the assertion it is being proffered to rebut.

Third, the Examiner's position is inconsistent. In particular, the Examiner previously allowed this application in view of the evidence of non-obviousness Applicants presented. Unfortunately, however, Applicants withdrew the Application from Issue in order to correct the named inventorship and to present additional art for the Office to consider. It was only after that withdrawal from Issue and re-opening of prosecution that the Examiner raised the specification issue *vis-à-vis* Applicants' evidence of skepticism and predictions of problems by others having skill in the art. If the Examiner previously considered Applicants' evidence to be sufficiently persuasive of non-obviousness to allow this application, why is it now not persuasive? In short, the Examiner's current position is completely inconsistent with his previous allowance of this application.<sup>11</sup>

Nevertheless, as Mr. Goldfinch explained at the interview, the present invention does not overcome the problems others predicted would occur; it avoids them altogether by a paradigm shift in thinking about power, volume, and the quality of signal necessary to achieve a satisfactory distributed audio system using category 5 cabling. What Mr. Goldfinch explained at the interview is reflected in the attached Declaration under 37 C.F.R. 1.132 of Leonard Andrews and Andrew Goldfinch.

In view of the foregoing and the attached Declarations, Applicants submit that this application is clearly in condition for allowance, and timely notice to that effect is respectfully requested.

Respectfully submitted,



KENNETH M. FAGIN  
Reg. No. 37615  
Tel. No. (301) 721-2583  
Fax No. (301) 560-8880

Date:

8/16/06

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<sup>11</sup> The only difference between the time the application was allowed and now is that Lamb et al. – a reference that has been available since September 10, 2002 – is now being relied on. The existence of Lamb et al., however, is irrelevant to the asserted deficiency of the specification.